

REMARKS

The present application has been reviewed in light of the Office Action dated September 5, 2003. Claims 14, 17-20, 22, 24, 26, and 28 are presented for examination. Claims 14, 22, 24, 26, and 28, the only claims in independent form, have been amended to define Applicants' invention more clearly. Favorable reconsideration is requested.

As an initial matter, section 2 of the Office Action dated December 18, 2002, indicates that the information identified in the Information Disclosure Statement (IDS) submitted on August 29, 2002, has been considered. Applicants note, however, that an initialed copy of the corresponding PTO-1449 form was not received with that Office Action. Therefore, Applicants requested return of such copy in the Response filed on May 19, 2003. The current Office Action does not address Applicants' request nor does it attach the requested copy, so Applicants again request that an initialed copy of the PTO-1449 form from the IDS submitted on August 29, 2002, be returned.

The Office Action states that Claims 14, 17-20, 22, 24, 26, and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,721,827 (Logan et al.) in view of U.S. Patent No. 5,588,009 (Will). Applicants respectfully traverse the rejections and submit that independent Claims 14, 22, 24, 26, and 28, together with the claims dependent therefrom, are patentably distinct from the cited prior art for at least the following reasons.

An aspect of the present invention set forth in Claim 14 is directed to a portable terminal apparatus that includes a display, an indicator, an extraction unit, a memory, and a transmitter. The display displays received information. The indicator includes a single

physical key for indicating an extraction of an information identification code and a transmission of the information identification code to an external device. The external device acquires information corresponding to the information identification code. The information identification code specifies information stored in the external device and indicates to the external device to display a window for designating printing conditions of the information.

When an extraction of an information identification code is indicated by the indicator, the extraction unit extracts at once all of an extractable information identification code from the information displayed by the display. The memory stores the information identification code extracted by the extraction unit. When transmission of an information identification code is indicated by the indicator, the transmitter transmits at once all of the information identification code stored in the memory to the external device.

One of the notable features of Claim 14 is that the portable terminal apparatus includes an indicator with a single physical key for indicating an extraction of an information identification code and a transmission of the information identification code to an external device. That is, the single physical key is assigned to extract the information identification code and to transmit the information identification code to the external device in a single operation. By virtue of this feature, the portable terminal apparatus efficiently uses a reduced number of physical keys relative to the number of physical keys of a keyboard of a personal computer or the like.

Logan et al. relates to a system for distributing entertainment programming to subscribers. As understood by Applicants, Logan et al. discloses the use of a keyboard 119 for

inputting a code, which is transmitted to an external device. The keyboard 119 is a conventional keyboard of a laptop or desktop personal computer (see column 3, lines 1-2 and 61-63). As such, the keyboard 119 is not constrained by size considerations, and generally there are no concerns regarding the number of keys present thereon.

In the Office Action, it is conceded that Logan et al. "fails to teach that the apparatus/method allowing to perform operation using a single physical key indicates to the external device to display designing print conditions of the information." Will is offered as a remedy for this deficiency of Logan et al.

Will relates to a paging system for delivering paging signals and messages to individuals within a building. As understood by Applicants, Will teaches that incoming messages, such as e-mail, telephone, and fax messages, are sent to individuals via radio communication within the building.

In the Office Action, it is asserted that "a single key (col 4 lines 40-55) indicates to the external device to display designing print conditions of the information (col 26 lines 59-67, col 27 lines 1-25)." Will, at lines 40-55 of column 4, recites the following:

While users can compose any response to a message or an original message, the miniaturization of the communications unit tends to make character entry laborious, and the system is designed on the assumption that responses usually involve the selection of preprogrammed responses included in the message, preprogrammed responses that can be selected from the memory of the unit, or very brief responses composed letter by letter. Examples of possible responses include "Message read and understood", "Will do", "Will call you back in 5 minutes", "Will call you tomorrow", etc. Responses are preferably selected or composed by means of a thumbwheel and single key, which takes up little space. The thumbwheel and key interface is described in detail in the copending application entitled

"Control of Miniature Personal Digital Assistant Using Menu and Thumbwheel."

Will, at column 26, line 59, to column 27, line 25, recites the following:

Display 452 shows the top line that is displayed when a user moves the thumbwheel to the highest position in the Display Memory. (Another way to get there is by reversing the rotation of the thumbwheel twice in rapid succession.) The top two lines display status indicators, with one or more of the indicators shown displayed at a given time, as appropriate. If "High" is displayed it indicates that one or more of the unread messages has a priority of High. If "Voicemail" is displayed it indicates that the user has one or more unheard voicemail messages. The user can either call the central voicemail system from a local telephone to listen to them or send a message asking that the messages be transcribed and sent to the communications unit. If "Fax" is displayed it indicates that a Fax message is waiting for the user. A message will also be received indicating which machine the Fax is at if there is more than one machine, and, optionally, a set of responses. If "Unread" is displayed, one or more messages have been received but not displayed by the user. Similarly, if "Print" is displayed it indicates that a print job is waiting for the user. If "Rcvr" is displayed it means that the received signal reliability has been less than 100% over the last N minutes, where N is typically 2. If "Trans" is displayed it means that a transmission from the unit has not been received by a remote station for the last N minutes, where N is typically 2. (The user can tell this from receipt of a Confirm Data packet). "OK" means that the signal reliability has been 100% since receipt of the last packet successfully transmitted to the specific unit, or since receipt of a Confirm Data indicating that all packets sent have been received. Below the status indicators are menu selections that cause the display to move to a particular point appropriate to a specific goal. This is simply a shortcut to reach these menus; the same effect can also be achieved by moving the thumbwheel to move the display window through the display memory.

One of ordinary skill in the relevant art would understand the cited portions of

Will to relate to using a thumbwheel 49 for scrolling through text displayed on a display portion

44 of a remote communications unit (see Fig. 4). The text corresponds to received messages. A key 48 is provided on the remote communications unit for selecting desired text displayed at a predetermined position on the display portion (see Fig. 4).

Nothing in Will is believed to even suggest using the key 48 to indicate an extraction of an information identification code and a transmission of the information identification code to an external device, as claimed in Claim 14. Therefore, it is respectfully submitted that one of ordinary skill in the relevant art would find no motivation to modify the Logan et al. system to include Will's key 48, and then to modify Will's key 48 such that the key is used to indicate an extraction and a transmission.

Applicants submit that it is now well settled that to support a rejection based on obviousness, it must be shown that there is "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teachings of the references." (*In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing *In re Fritch*, 23 USPQ 1780, 1783 (Fed. Cir. 1992).) The motivation to combine and a reasonable expectation of success of the combination must both be found in the prior art and not in the disclosure of the application under examination. (MPEP 2143 and 2143.01; *In re Vaack*, 20 USPQ2d 1438 Fed. Cir. 1991).)

Applicants submit that a combination of Logan et al. and Will, assuming such combination would even be permissible, would fail to teach or suggest a portable terminal apparatus that includes "an indicator comprised of a single physical key for indicating an extraction of an information identification code and a transmission of the information

identification code to an external device, wherein the external device acquires information corresponding to the information identification code, and wherein the information identification code specifies information stored in the external device and indicates to the external device to display a window for designating printing conditions of the information," and "an extraction unit for, when an extraction of an information identification code is indicated by said indicator, extracting at once all of an extractable information identification code from the information displayed by said display," and "a memory for storing the information identification code extracted by said extraction unit," and "a transmitter for, when transmission of an information identification code is indicated by said indicator, transmitting at once all of the information identification code stored in said memory to the external device," as recited in Claim 4.

At best, Applicants submit that a combination of Logan et al. and Will would, even if such combination is permissible, merely result in a system for distributing entertainment programming to subscribers that includes a keyboard and a thumbwheel for scrolling through text displayed on a display portion, wherein a key is provided on the keyboard for selecting desired text displayed at a predetermined position on the display portion. One of ordinary skill in the relevant art would find no suggestion or motivation in either Logan et al. or Will to use the key to indicate an extraction of an information identification code and a transmission of the information identification code to an external device, as claimed in Claim 14.

Accordingly, Applicants submit that Claim 14 is patentable over the cited art, and respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a). Independent Claims 22, 24, 26, and 28 include features similar to those of Claim 14 and therefore are believed to be

patentable for at least the same reasons. Likewise, the other rejected claims in this application depend from Claim 14 and therefore are submitted to be patentable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

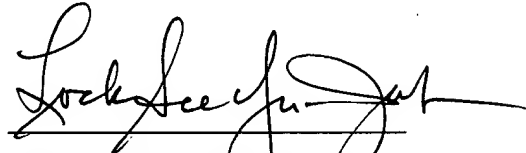
In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

No petition to extend the time for response to the Office Action is deemed necessary for the present Amendment. If, however, such a petition is required to make this Amendment timely filed, then this paper should be considered such a petition and the Commissioner is authorized to charge the requisite petition fee to Deposit Account 06-1205.

CONCLUSION

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Lock See Yu-Jahnes", written over a horizontal line.

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